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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,782	03/29/2001	Sunil Kumar Verma	U 013365-9	5526

7590

08/16/2005

Ladas & Parry
26 West 61st Street
New York, NY 10023

EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,782

Applicant(s)

VERMA ET AL.

Examiner

Suryaprabha Chunduru

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 8-26 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 8-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-21, 23 and 25 is/are rejected.
- 7) ☒ Claim(s) 22, 24 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicants' petition to withdraw the abandonment has been considered and the case is reopened.
2. Applicants' response to the office action filed on May 24, 2005 has been entered.
3. Claims 1-5, and 7 are cancelled. New claims 17-26 are added. Claims 6, 8-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group.

Status of the Application

4. Applicants' response to the office action is fully considered and found persuasive in part. All arguments have been fully considered and thoroughly reviewed, but are deemed persuasive in part for the reasons that follow. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. This action is made FINAL necessitated by amendment.

New Grounds of Rejections necessitated by Amendment

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The instant claim 18 is dependent on cancelled claim 1 and thus the meets and bounds of the claim 18 are unclear and indefinite Amendment to recite proper dependency would obviate the rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-21, 23, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Matthee et al. (Mol. Phylogent. Evolution., Vol. 12 (1), pp. 31-46, 1999).

Note : Claims are given the broadest scope of interpretation in view of the “essentially comprising” or “consists essentially of” format is open language as “comprising” of the instant claims. The following rejection is based on a nucleic acid sequence comprising the primer sequences and the term ‘primer’ in the preamble is broadly interpreted as a nucleic acid sequence.

Matthee et al. teach a nucleic acid sequence of claim 17, 20-21, 23, 25 of mitochondrial DNA cytochrome b gene (1140 bp) comprising the sequences of SEQ ID No. 1-2 and a fragment comprising SEQ ID No. 211 as claimed in the instant claims (see enclosed sequence alignment from GenEmbl. database showing the sequence comprising primers SEQ ID Nos. 1 and 2, and a fragment comprising SEQ ID No. 211).

With regard to claims 17-20, Matthee et al. also teach said fragment discriminates various evolutionary lineages (species/ subspecies) (page 44, FIG. 5), the fragment flanks highly conserved sequences amongst a vast range of animal species (see page 35, col. 2, paragraph 1 under result and discussion section, page 38, col. 2, paragraph 2), polymorphic inter-specifically, but monomorphic at intra species sources (see page 31, abstract, and page 43, col. 2,

paragraph 1 under conclusions section, page 44, FIG. 5, indicates no significant heterogeneity between taxa (genus level) (monomorphic at intra species), but variation within the species).

Thus the disclosure of Matthee et al. meets the limitations in the instant claims.

Response to arguments:

7. With regard to the objection to the specification made in the previous office action, Applicants' arguments are fully considered and found unpersuasive. The objection is maintained until the hyper-link is removed.

8. With regard to the rejections made in the previous office actions under 35 USC 112, second paragraph, Applicants arguments and amendment are fully considered and the rejections are withdrawn in view of the amendment canceling the claims 1-5.

9. With regard to the rejection made in the previous office action under 35 USC 102(b), Applicants arguments and amendment are fully considered and the arguments are found not persuasive. Applicants argue that the transitional phrase is amended to recite "essentially comprising of" / "consists essentially of" and would obviate the rejection. Applicants' arguments are not persuasive because the recitation of "essentially comprising of" / "consists essentially of" is an open end or "comprising" format thus the scope of the claims is not changed and the limitations in the new claims 17-21 do not exclude the limitations taught by Matthee et al. Thus the rejection is re-written to address the new claims.

10. With regard to the rejection made in the previous office action under 35 USC 103(a), Applicants arguments and amendment are fully considered and the rejection is withdrawn herein in view of the amendment and new grounds of rejections.

Allowable Subject Matter

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11. Claims 22, 24, 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

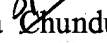
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M , Mon - Friday,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Suryaprabha Chunduru
Examiner
Art Unit 1637


JEFFREY FREDMAN
PRIMARY EXAMINER

8/15/05